

Remarks

The Examiner has required restriction to one of three groups of inventions, Groups **I-III**, under 35 U.S.C. §121. Group I, represented by claim 15, is drawn to piperidiny compounds. Generic claims 1-14 and 16-37 reading on an elected compound where $m+n=4$ can be examined with this group. Group II, represented by claims 1-14 and 16-37, is drawn to $m+n$ is not 4. Group III, represented by claim 38, is drawn to a method of treating disease or symptom by administration of the claimed compounds.

Applicants hereby provisionally elect to prosecute Group I, claim 15 and generic claims 1-14 and 16-37 where $m+n=4$. This election is made without prejudice or disclaimer to the other claims or inventions disclosed.

In addition, Applicants hereby provisionally elect 2-[4-(4-fluoro-benzyl)-piperidin-1-yl]-2-oxo-N-(2-oxo-2,3-dihydro-benzoxazol-6-yl)-acetamide. This compound is a compound of Formula I. The synthesis of this compound is described in Example 3. Claims 1-37 read upon this elected species. Applicants assert the right to claim additional species in the event that a generic claim hereto is found allowable in accordance with 37 C.F.R. § 1.141(a). This election is made without prejudice or disclaimer to the other claims or inventions disclosed.

Furthermore, should rejoinder with method of treatment claim 38 occur after allowance of claims 1-37, Applicants elect the single disclosed species of alleviating the symptom of pain. Applicants assert the right to claim additional species in the event that a generic claim hereto is found allowable in accordance with 37 C.F.R. § 1.141(a). This election is made without prejudice or disclaimer to the other claims or inventions disclosed.

All elections are made **with** traverse. Applicants respectfully submit that restriction to one of three groups of inventions is not proper.

The test for proper joinder of invention within a claim is whether unity of invention exists. Unity of invention exists for compounds when the compounds share a common structural core and share a community of properties, such that the grouping of such compounds together is not repugnant to principles of scientific classification. *See in re Harnish*, 206 U.S.P.Q. 300 (C.C.P.A. 1980). Whether “a prior art anticipating the claim with respect to one of the members would not render the other members obvious under 35 U.S.C. 103” is not a proper standard for restriction requirement.

The claims are directed to compounds that share a common core or nucleus as depicted by Formula I, as described in the specification. The compounds share a common utility, namely effective and selective antagonism of NMDA receptors. Thus, the claims are directed to subject matter for which unity of invention exists. Further, it is submitted that the compounds of claim 15 are defined by a proper Markush group. *See* M.P.E.P. § 803.02. Similarly, coumarin compounds having a bicyclic structure that could be benzo-fused to an additional heterocyclic ring to form a tricyclic structure, said compounds sharing similar properties were found to share a common nucleus or core, and found to share a common utility in *In re Harnish*. Applicants therefore respectfully submit that the genus of claim 1, and the more narrow sub-genuses of claims 2-37 meet the unity of invention test.

M.P.E.P. § 803 (Eighth Edition, August 2001), at page 800-4, left hand column, states as one of the criteria for proper requirement for restriction that: “[t]here must be a serious burden on the examiner if restriction is required. . . .” Thus, the Patent Office

encourages the search and examination of an entire application on the merits, where such search and examination can be made *without* serious burden. Applicants respectfully assert that the search of restricted Groups I-III does not impose a serious burden upon the Examiner, as search concerning the patentability of the invention of Group I will clearly uncover art of interest to the other groups. At least, the search of restricted Groups I-III does not impose a serious burden to the Examiner in view of above.

Thus, Applicants submit that in the present case, restriction to one of three groups and to a single species of compound, as required by the Examiner, is improper and presents an undue burden to Applicants to prosecute several patent applications.

Applicants respectfully request that the claims of Groups I-III be examined together.

Reconsideration and withdrawal of the Restriction and Election of Species Requirements, and consideration and allowance of all pending claims, are respectfully requested.

Respectfully submitted,

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